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GENENTECH, INC.  
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South San Francisco, CA 94080

In re Application of  
Lam et al.  
Application No. 09/724,868  
Filed: November 28, 2000

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**OFFICE OF PETITIONS**

: DECISION GRANTING PTA  
: APPLICATION

This decision is in response to Applicants' APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) timely<sup>1</sup> filed on March 7, 2005 requesting that the Office adjust the PTA determination at the time of the mailing of the notice of allowance from a determination of three hundred and seventy-seven (370) days to a determination of four hundred and seventy-seven (477) days.

The applicants' application for PTA is **GRANTED**. The Office will adjust the PAIR calculation at the time of the mailing of the notice of allowance to reflect that 477 days of adjustment has been determined.

Applicants assert that the Office erred in assessing the reduction as a supplemental response under 37 CFR 1.704(c)(8) because the submission of the IDS documents was a duplicate copy filed at the examiner's request for such IDS. Applicants assert that the specific IDS had in fact been submitted prior on February 2001 and the re-submission on May 28, 2005 was in fact a duplicate of what was previously submitted and provided as a courtesy at the examiner's request.

Applicants arguments are persuasive. Although the examiner failed to include an interview summary of the conversation as should have been done to have a complete file history. The record reflects that applicants' arguments are accurate. Specifically, the file history reflects that the same submission had in fact been submitted by applicants on February 15, 2001. Applicant submitted a postcard stamped receipt of such submission. In addition, applicants submission of May 28, 2004 reflects that the examiner had expressly requested the information and noted such per the following submission; "per voice mail request this morning, attached is a copy of the IDS, form 1449, and PTO stamped postcard receipt". Accordingly, pursuant to rule 37 CFR 1.704(c)(8), applicants will not be assessed a failure to engage in reasonable efforts to conclude processing and examining of the application if the supplemental response is expressly requested by the examiner. The record viewed as a whole reflects that the submission of the IDS on May 28, 2004 was in fact expressly requested by the examiner.

After the mailing of this decision, the application file will be forwarded to the Office of Patent Publication for a prompt issuance of the patent. Additional delays in issuing the patent beyond

<sup>1</sup>Issue fee paid concurrently with the petition.

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four months of the payment of the issue fee will be reflected in the issue notification letter that is mailed to applicants approximately three weeks prior to issue date.

The Office has charged deposit account No. 07-0630 the \$200.00 fee. No additional fees are required by the Office.

Any questions concerning this decision should be directed to Kery Fries, Senior Legal Advisor, at 571-272-7757.

*Kery Fries*  
Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

cc: Adjusted PAIR calculation